## REMARKS

Reconsideration of the outstanding Office Action is respectfully solicited.

Applicants respectfully traverse the rejections of the claims under 35 U.S.C. 101, although the rejection is rendered moot: the Claims have been amended to recite "A biological pure isolate".

Applicants respectfully traverse the rejections of the claims under 35 U.S.C 102/103 over Endo.

Even if both microorganisms belong to the genus Arthrobacter and exhibit some common properties as pointed out by the Examiner, the Claims should not be rejected under Endo et al.

Specifically, the USPTO rejected Claims 21-23 under Endo et al. (USP 5,707,836), on page 3 of this Official Action. The Examiner relies on the specification to allege that some properties of Arthrobacter FERM BP-6444 are common to KK-3 of the Endo reference. Applicants rely on MPEP Section 2131 for the synopsis of the case law of anticipation: in order for the reference to be used as a grounds of anticipation, the reference must teach each and every element of the claim.

The application specification pages 9-10 (relied upon by the PTO) states,

| | |
|---|---|
| Morphology | polymorphic rod bacteria |
| Gram stain | Positive |
| Spores | Negative |
| Motility | Positive |
| Relation to oxygen | Aerobic |
| Oxidase | Negative |

| | |
|---|---|
| Catalase | Positive |
| OF | Negative |
| Resistance to acidity | Negative |
| Color of colony | not forming characteristic pigments |
| Rod coccus cycle | Positive |
| Elongation of peripheral cells in colony | Negative |
| Cell wall | |
| Diamino acid | Lysine |
| Acyl-type | acetyl-type |
| Arabino-galactan polymer (assumed using acidic hydrolysis products of the whole cell) | Negative |
| Main quinone series | MK-9 (H2) |
| GC content in the DNA (mole percent: measured by HPLC method) | 65 |

By comparison, the Endo reference states at column 3 through column 4:

| | Strain KK-3 |
|---|---|
| Morphology | Polymorphic bacilliform |
| Gram staining | + |
| Spore | - |
| Mobility | - |
| Require for free oxygen | Aerobic<br>- |
| Oxidase | - |
| Catalase | + |
| Color of colony | No characteristic color |

| | |
|---|---|
| Acid fastness | - |
| Rod-coccus cycle | + |
| Elongation around colony | None |
| Diamino acid of cell walls | Lysine |
| Glycolyl test | -(acetyl type) |
| Arabinoogalactam polymer of cell walls | -(estimated from acid hydrolyzate of all cells) |
| Quinone system | MK-9(H2)... |
| GC content of DNA.. | 65 |
| | |

Accordingly, the Endo written description differs from the description at apge 9 et seq. of the subject application. Accordingly, the Claimed subject matter is not anticipated by the Endo reference. Cf. MPEP 2131.

Moreover, in applicants' view, the reference does not provide a prima facie case of obviousness under 35 U.S.C. 103.

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As recited in the pending Claim 21 directed to Arthrobacter FERM BP-6444, an essential feature of Arthrobacter FERM BP-6444 lies in the activity for decomposing a polyester containing an aromatic moiety.

On the other hand, the method described in Endo et al. (including Arthrobacter Strain KK-3) is directed to production of an optically active amino acid. As described in Endo et al (for example in Claim 1), such method is achieved by using microorganisms having lyase activity and being capable of producing the optically active amino acid. Therefore, Arthrobacter Strain KK-3 has enzymatic activity as a lyase, which is also described in EXAMPLE 2 of Endo et al.

Considering it, the reaction catalyzed by Arthrobacter FERM BP-6444 (present invention) and that catalyzed by Arthrobacter Strain KK-3 (Endo et al) are apparently different. Thus Endo et al. fails to teach or suggest the essential feature of the microorganism according to Claims 21-23, that is, having the activity for decomposing a polyester containing an aromatic moiety. Accordingly, in applicants' view, the reference does not provide a prima facie case of obviousness.

An early allowance is respectfully solicited.

Respectfully submitted,

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